

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shahana RAHMAN et al.

Group Art Unit: 2625

Application No.: 10/830,111

Examiner: S. BRINICH

Filed: April 23, 2004

Docket No.: 118445

For: SYSTEMS AND METHODS FOR FORMING COMPOSITE IMAGES WITH  
DIGITAL GRAPHIC ELEMENTS

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the August 22, 2008 Office Action, reconsideration of the application is respectfully requested in light of the following remarks.

Claims 1-6, 8, 15, 19, 20 and 22-26 are pending in this application.

The Office Action, on page 2, rejects claims 1-6, 8, 15, 19, 20 and 22-26 under 35 U.S.C. §103(a) as being unpatentable over Micrografx Picture Publisher Limited Edition Reference Guide (hereinafter "Micrografx") in view of U.S. Patent No. 5,146,275 to Tone et al. (hereinafter "Tone"). These rejections are respectfully traversed.

Claim 1 recites an image forming device, comprising: an imaging source that scans an input document to obtain input image data, a digital graphic element forming unit that processes user-supplied digital graphic element data, a composite image forming device that forms a composite image based on the obtained input image data and the user-supplied digital

graphic element data, and an output unit that prints the composite image on an image receiving substrate. Claim 20 recites similar features.

With reference to Micrografx at pages 7-40 to 7-44, the Office Action asserts that Micrografx can reasonably be considered to teach many of the features positively recited in the pending claims. The Office Action concedes that Micrografx does not describe a scanner which scans an input document to obtain input image data or an image forming device that forms and stores a composite image based on the obtained input image data and the user-supplied digital graphic element data. The Office Action relies on Tone as teaching such a feature.

Tone is directed to a composite image forming apparatus including an analog or a digital image forming apparatus of the type in which an optical system moves relative to a document placed on a document table. The image on the document is scanned by the optical system. The image is transferred to a sheet of image transferring paper in a belt like recording medium on which additional or optional images from which additional or optional images other than the document image can be transferred to the sheet of image transferring paper (Abstract). The Office Action summarily concludes that it would have been obvious to combine Micrografx with Tone, to apply the control arrangements and interface of Micrografx to the Tone scanner and printer device and to enable the Tone device to carry out the full range of image processing described in Micrografx. To the extent that this is an objective of Micrografx or Tone, the analysis of the Office Action regarding the combination of Tone with Micrografx fails for at least the following reasons.

First, MPEP §2142 instructs that the proper standard by which to determine obviousness requires (1) that the Examiner step backward in time into the shoes of the hypothetical "person of ordinary skill in the art," (2) that "in view of all the factual information, the Examiner must then make a determination whether the claimed invention 'as

a whole' would have been obvious at the time to that person," and (3) that any knowledge gained from Applicants' disclosure must be put aside at reaching this determination in order to avoid the tendency to resort to the impermissible application of hindsight reasoning based on the roadmap provided by Applicants' disclosure. Clearly, there is nothing in Tone and/or Micrografx to suggest that one of ordinary skill in the art at the time of Applicants' invention may have, in any way, predictably combined Tone with Micrografx in the manner suggested by the Office Action, and such has not been adequately shown.

Second, to any extent that Micrografx and Tone are combinable, it is not reasonable to conclude that one of ordinary skill in the art would have predictably combined Micrografx with Tone to overly complicate the Tone device. Micrografx functions on a user PC from which the work product may be sent to a printer. Tone teaches a device that scans a document and transfers the image to a sheet of image transferring paper upon which optional images other than the document image can be transferred to. Tone teaches in Fig. 3, that the additional mark is selected via the mark selecting means (see col. 10, lines 17-22) for selecting one or two or more optional marks in the mark scanning area 4b (Fig. 1(b)) of a plurality of marks described on the recording medium and is provided with a singularity mark changer switch 11 and a plurality mark changer switch 12. Therefore, because the marks are selected in Tone via a selecting means, they are selected from a predetermined database of marks. In this regard, because Tone already transferred predetermined marks to the transfer paper, the Office Action fails to show why one of ordinary skill in the art would predictably modify the design of Tone to include the Micrografx Picture Publisher.

For at least the foregoing reasons, Micrografx and Tone are not combinable in any manner suggested by the Office Action to render the pending claims obvious. Therefore, claims 1 and 20 are allowable. Further, claims 2-6, 8, 15, 19 and 22-26 also are allowable at least for the respective dependence of these claims, directly or indirectly, on an allowable

base claim and/or any intervening claim, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejections of claims 1-6, 8, 15, 19, 20 and 22-26 under 35 U.S.C. §103(a) as being unpatentable over the asserted references are respectfully requested.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-6, 8, 15, 19, 20 and 22-26 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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Date: September 19, 2008

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